

REMARKS

Upon entry of this amendment, claims 1-21, 23, 24, 26-29, and 43 are pending in this application. Claims 22, 25, 29, and 30 have been cancelled without prejudice or disclaimer of the subject matter therein. Claims 1-21, 23, 24, and 26-28 have been amended. Withdrawn claims 31-42 have also been cancelled without prejudice or disclaimer of the subject matter contained therein. Claim 43 has been added. No new matter has been added. In view of the above amendments and the following remarks, reconsideration and further examination are requested.

Initially, Applicants note that a number of editorial amendments have been made to the specification and abstract for grammatical and general readability purposes. Due to the number of changes made, a substitute specification and abstract are submitted herewith. No new matter has been added. Also enclosed is a marked-up copy of the original specification and abstract showing the changes incorporated into the substitute specification and abstract.

On page 2 of the Office Action, original claims 1-30 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of co-pending Application No. 10/485,646. Applicants file herewith a Terminal Disclaimer, thereby overcoming the double patenting rejection of claims 1-30, and any similar rejection of the amended and new claims.

On pages 3 and 4 of the Office Action, original claims 1-4, 7-22, and 25-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by Karafillis et al. (U.S. 6,353,768; hereinafter "Karafillis"); and original claims 1-30 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over Karafillis. These rejections are respectfully traversed, and in any event, are believed to be clearly inapplicable to the present claims, for at least the following reasons.

In rejecting claim 1 in view of Karafillis, the Examiner generally states that “Karafillis teaches determining heat treatments . . . and deformations to be applied to a structural member employing computer programs and a finite elements method to determine the heat treatments to be employed to allow for the desired deformation behavior where the parameters measured and relied upon meet the broadly recited parameters and conditions in the above claims.”(*Office Action*, p. 3).

However, a claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Furthermore, to establish a *prima facie* case of obviousness, the prior art reference must teach or suggest *all the claim limitations*. Claim 1 recites a method comprising, *inter alia*, (1) simulating the deformation behavior of a structural member when subjected to an applied stress using monitored data of the structural member; (2) simulating the effect of at least one heat treatment upon at least a region of the structural member; (3) determining a suitable heat treatment to apply to at least the region to produce a modified deformation behavior of the structural member; and (4) applying the suitable heat treatment to the structural member. As is clear from above quoted portion of the Office Action, the Examiner’s rejection does not specifically address each of the aforementioned limitations of claim 1.

In addition, Applicants note that the cited portion of the Karafillis reference only mentions ”modeling of intermediate anneals” and does not seem to reasonably suggest the above-

identified features of the present invention, as recited in claim 1. In contrast to the present invention, the remaining portion of the Karafillis reference describes a process for manufacturing sheet metal parts. Karafillis does not appear disclose or in any way suggest a process for modifying the deformation behavior of a structural member, which involves the steps recited in claim 1 (*See Abstract*; Col. 2, lines 1-30).

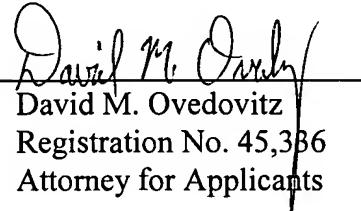
Accordingly, it is respectfully submitted that Karafillis does not anticipate or render obvious the present invention of claim 1. Furthermore, there appears to be no disclosure or teaching in Karafillis or the other references of record that would have lead a person of ordinary skill in the art to have modified Karafillis in such a manner as to result in, or otherwise render obvious to present invention of claim 1. However, should the Examiner persist in these rejections, Applicants kindly request that the Examiner provide specific references to the portion(s) of Karafillis which are considered to disclose or suggest the aforementioned limitations of claim 1. Otherwise, it is believed apparent that claim 1, as well as claims 2-21, 23, 24, and 26-28 which depend therefrom, are patentable over the references of record.

New independent claim 43 recites a computer readable medium encoded with a computer program for determining a heat treatment to apply to a structural member so as to modify the deformation behavior of the structural member. The computer readable medium is recited as causing the computer to execute a method comprising steps similar to those recited in claim 1, as discussed above, which appear to be lacking from Karafillis and the other references of record. Accordingly, claim 43 is also believed to be patentable over the references of record.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Borge BJORNEKLETT et al.

By: 

David M. Ovedovitz
Registration No. 45,386
Attorney for Applicants

DMO/lkd
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
July 1, 2008